

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) P06835US00													
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,705</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 45%; text-align: center;"> <p><u><i>Wendy K. Marsh</i></u> Signature</p> <p><u>WENDY K. MARSH</u> Typed or printed name</p> <p><u>(515) 288-3667</u> Telephone number</p> <p><u>8/19/08</u> Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>															
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>															

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. 35 U.S.C. § 112, First Paragraph - Written Description

The Examiner first rejected claims 1-5 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

(A) The Examiner states there is no support for excluding the preheating step in claims 1-2 (6/12/08 Action, p. 2). Referring to the published application, ¶ 4 notes that, "[t]he disadvantage of the closest analog is impossibility of aluminum melt applying on cast iron and steel products at the temperature lower than 715°C without using fluxes and the presence of intermetallic compounds of quite a big thickness (10-15 micrometers) making the coating brittle, which doesn't allow to deform the steel product with aluminum coating hereinafter." The Summary of the Invention then notes that the present invention, "solves the problem of decreasing the temperature of aluminum melt,..." Thus, the disclosure specifically states that it solves the problem in the art of applying aluminum melt at high temperatures by decreasing the temperature of the aluminum melt. Such resolution of the problem in the art therefore cannot occur by including a preheating step. Hence, the specification adequately supports this provision in claim 1, and meets the written description requirement of 35 U.S.C. § 112, first paragraph.

(B) The Examiner next states that "introduction of copper to the melt" in claim 2, last line is not supported by the disclosure as originally filed. (6/12/08 Action, p. 5). The inquiry into whether the description requirement of 35 U.S.C. § 112, first paragraph is met is a question of fact. *In re Wertheim*, 541, F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). Whether the description is adequate to support a later claimed invention depends on whether the disclosure of the application originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. Lack of literal support, in and of itself, is not sufficient to establish lack of adequate descriptive support. *In re Kaslow*, 707 F.2d 1366, 1373, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The description requirement of the first paragraph of 35 U.S.C. § 112 may be satisfied if there is support in the original disclosure for the concept of what is later claimed. *In re Anderson*, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973).

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Wendy K. Marsh

In this case, the concept that Appellants' process does not involve introduction of copper into the melt is reasonably conveyed from the specification as originally filed. In this regard, Appellants specifically describe in the Summary of the Invention that their method of applying aluminum coatings on cast iron and steel products comprises, "plunging the product into the aluminum melt alloyed with zinc and silicon the solution of said problem is reached by jet-abrasive preparing of the product and the aluminum melt is alloyed with zinc, silicon, magnesium, tin..." (Para. 6). Further, all of the preferred embodiments of Appellants' described invention disclose only the use of these elements. Nowhere does the disclosure suggest or describe the use of other elements besides zinc, silicon, magnesium, and tin as alloys. Certainly, the disclosure does not suggest to persons skilled in the art that copper is a suitable alloy for use in the invention. For these reasons, the original disclosure supports the added claim language which states that the process does not involve introduction of copper into the melt and meets the legal requirements of 35 U.S.C. § 112, first paragraph.

(C) Next, the Examiner states there is no support for the language in claim 3, line 9 which provides that said plunging in aluminum melts is "for a period of less than 5 minutes." (6/12/08 Office Action, p. 8). In the response dated 4/22/08, Appellants amended claim 3 to describe that said plunging occurs for a time period of 2 minutes or less. This time period is literally supported by Tables 1 and 2 which describe time periods from 2 minutes (120 seconds) and less.

II. 35 U.S.C. § 112, First Paragraph - Enablement

Claims 1-5 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. In this regard, the Examiner states that there is insufficient description "of how the 'Mandrel test' works such that this test can be reproduced, understood or compared, and thus one of ordinary skill in the art would not be able to make and/or use the invention." (6/22/08 Action, p. 9). In the response dated April 22, 2008, claims 1-5 were amended to specifically note that the Mandrel test employed uses a mandrel having a minimum diameter of 10 mm, as set forth on page 3 of the specification.

A specification complies with the 35 U.S.C. § 112, first paragraph, enablement requirement if it allows those of ordinary skill in the art to make and use the claimed invention without undue experimentation. See *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993). A simple Google search on the Internet demonstrates that the Mandrel test is a commonly known test in the industry for, "the test for determining the flexibility and adhesion of surface coatings by bending coated metal panels around mandrels." (See e.g. definition of "Mandrel test" on "composite.about.com.") The standard for enablement does not require Appellants to explicitly describe terms that are well known in the art, such as "Mandrel test." See e.g. MPEP Section 2164.04. Moreover, in order to make a rejection, the initial

burden is on the Examiner to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). In this case, it is clear that "Mandrel test" is a term that persons skilled in the field of the claimed invention are well familiar. Further, the Examiner has failed to meet the initial burden of demonstrating a reasonable basis as to why persons skilled in the art have insufficient evidence to make and use the claimed invention, keeping in mind that experimentation is permitted under the enablement standard of Section 112, so long as it is not "undue." The Examiner has therefore not met the legal burden under Section 112, first paragraph.

III. 35 U.S.C. § 112, Second Paragraph

Claims 1-5 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. First, in the 6/22/08 Action, p. 11, the Examiner stated that in claim 1, "or preheating to within austenitic temperatures" is confusing as to what is required. In the 4/22/08 response, Appellants amended claim 1 to specify that the coatings are applied on the cast iron and steel products without preheating prior to the plunging step. It is only during the plunging step that the temperature of the melt is in the range of 660-680°C. This specifying statement is therefore not inconsistent with the remainder of the claim and is sufficiently definite under 35 U.S.C. § 112, second paragraph.

Second, the Examiner objected to the language pertaining to the Mandrel test in claim 1. (6/22/08 Action, p. 12). Again, the claims were amended such that it is believed the reference to the Mandrel test is sufficiently clear, especially to persons skilled in the art that are already familiar with the Mandrel test as to do so would be redundant and not legally required by § 112, second paragraph.

Finally, in claim 4, the Examiner states that "or preheating the product prior to plunging in the melt" is confusing as to what is required. (6/22/08 Action, p. 13). It is not understood what is confusing about this statement. In this regard, the claim simply states that the product is not preheated prior to plunging in the melt. That is unambiguous, and would not allow for heating prior to the coating step. The language itself disallows the options raised by the Examiner in the rejection, and is therefore sufficiently clear under 35 U.S.C. § 112, second paragraph.

IV. 35 U.S.C. § 103

Claims 1-2 and 4-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rallis in view of Japan '213. (6/22/08 Action, p. 14). A claimed invention is not patentable if the subject matter of the claimed invention would have been obvious to a person having ordinary skill in the art. 35 U.S.C. § 103(a); *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007); *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

The combination of Rallis and Japan '213 fail to teach or suggest the provisions of the claimed invention, as Rallis requires preheating prior to the plunging step to a temperature above 1341°F to within the austenitizing temperature range of the carbon or alloy steel. (Col. 2, lines 18-21). Such preheating is disallowed by all of the claims. Japan '213 fails to provide this missing teaching as it does not disclose any process, but only an aluminum alloy.

It is the Examiner's position that, "it would have been obvious to perform the coating method of Rallis in view of '213 without preheating" on the basis that, "it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art," citing *In re Karlson*, 136 USPQ 184 in support. (6/22/08 Action, p. 17). While there is some support in the case law for the principle that omission of an element and its function involves only routine skill in the art, the court has also recognized that this is not a mechanical rule, and that the language in *Karlson* was not intended to short circuit the determination of obviousness mandated by 35 U.S.C. § 103 (see *In re Wright*, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965)). Further, Appellants direct the Examiner's attention to *In re Ochial*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) wherein the Federal Circuit held that the claimed invention as a whole must be evaluated under the standards set down in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 466 (1966) and its progeny, and that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. § 103 since such rules are inconsistent with the fact-specific analysis of claims and prior art mandated by Section 103.

Here, the Examiner has failed to meet the initial burden of proof for obviousness by failing to provide a reasonable suggestion for eliminating the preheating step of Rallis. In fact, Rallis teaches away from such elimination by virtue of its disclosure that said heat treatment is necessary in order to increase the yield strength of the steel article to a minimum of 60,000 psi. (Abstract). Thus, the Examiner has failed to provide a *prima facie* case of obviousness.

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Giersek et al. in view of Rallis and Japan '213. (6/22/08 Action, p. 18). Giersek does not disclose alloying of an aluminum melt with zinc, silicon, magnesium and tin. Rather, Giersek discloses an aluminum alloy that can contain aluminum and a single alloying metal such as zinc, silicon, magnesium or tin. More particularly, Giersek is limited to a single alloying metal. There is no teaching or suggestion to modify the teachings of Giersek to alloy an aluminum melt with these four claimed metals. Further, it is again noted that Rallis in view of Japan '213 do not teach the preparation of aluminum alloy on cast iron and steel products without preheating prior to the plunging step to a temperature within the austenitizing temperature

range of the carbon or alloy steel. Giersek also teaches preheating within the austenitizing temperature range, with upper bounds 270°C higher than the upper temperature allowed by the present invention.

The Examiner argues that where claimed ranges overlap or lie inside ranges disclosed by the prior art, a prima facie case of obviousness exists. (6/22/08 Action, p. 19). Again, however, the law of obviousness does not support such an automatic rule. While optimization of a known result-effective variable in a given range is generally obvious, *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003); *In re Aller*, 220 F.2d 454, 456 (CCPA 1955), it is only when it is reasonably expected that an improvement will arise in that range. See e.g. *Ex parte Atkinson*, Appeal 2007-3900 (December 18, 2007). Here, it is not clear what result the Examiner thinks would be "optimized" by substantially lowering the temperatures described by Giersek to below austenitizing range to arrive at Appellants' claimed preheating temperature range. For this reason, the Examiner has not met the initial burden for establishing a prima facie case of obviousness.

With respect to the lack of copper in the claimed invention, the Examiner asserts that the statement in Japan '213 that a desirable aluminum alloy includes 0.5% copper is "a typographical error." (6/22/08 Action p. 25). The Examiner's reasoning is that p. 61, first column teaches 0-5% copper, which the Examiner argues means that no copper can be used in the alloy. Appellants would respectfully note that is more likely that 0-5% copper is more likely the typographical error, and is intended instead to read "0.5% copper." Thus, the Examiner's assertion that Japan '213 teaches an aluminum alloy without copper is in error. Reconsideration and allowance is respectfully requested.